

REMARKS

Introductory Comments:

Claims 24-40 and 50-55 were examined in the Office Action under reply. Claims 24-26 and 40 were objected to; claims 27-33 and 37-39 were rejected under 35 U.S.C. §102; claims 34-36, and 50-55 were rejected under 35 U.S.C. §103(a). These rejections are believed to be overcome as discussed more fully below.

The Examiner alleges the declaration that accompanied the application is defective because it was not signed by Peter Colosi. However, applicant submitted a signed declaration on June 1, 2001. A copy of the declaration, as well as a copy of the postcard stamped by the Patent Office indicating receipt of the signed declaration, is appended for the Examiner's convenience. Thus, this basis for objection is in error and withdrawal thereof is respectfully requested.

Overview of the Above Amendments:

The specification has been amended to refer to the subparts of Figure 7, as requested by the Examiner.

Claims 1-23, 27-36 and 38-55 have been cancelled herein. Claims 24-26 have been amended to read in independent format and incorporate the limitations from claims from which they previously depended. Claim 37 has been amended to incorporate the recitations from claims 39 and 40. Thus, claim 37 now corresponds to previous claim 40.

New claims 56-69 have been added. Claims 56-63 and 64-67 correspond to cancelled claims 3-10 and 12-15, respectively, rewritten to ultimately or directly depend from claim 24. Claim 68 corresponds to cancelled claim 17, rewritten to depend from claim 25, and claim 69 corresponds to cancelled claim 19, rewritten to depend from claim 26.

Support for the amendments can be found in the claims as originally filed, as well as throughout the specification.

The foregoing amendments are made without prejudice, without intent to abandon any originally claimed subject matter, and without intent to acquiesce in any rejection of record. Applicant expressly reserves the right to file one or more continuing applications

hereof containing the cancelled or unamended claims.

Rejections Over the Art:

Claims 27-33 and 37-39 were rejected under 35 U.S.C. §102. Claims 34-36 and 50-55 were rejected under 35 U.S.C. §103(a). Applicants note that claims 24-26 and 40 were not subject to an art rejection. In particular, the Office notes that “claims that recite the limitation of an accessory vector comprising an adenovirus E1B region lacking an intact E2B55k coding region are free of the prior art.” Office Action, page 21.

Claims 24-26 have been rewritten in independent format to incorporate the recitations from the claims from which they directly and ultimately depend. Additionally, as explained above, claim 37 now corresponds to claim 40 as the recitations from claims 39 and 40 have been added thereto. All of these claims recite that the E1B coding region present lacks an intact E1B55k coding region. The remaining claims all ultimately or directly depend from claims 24-26 and are therefore also free from the art.

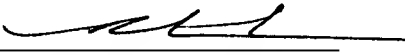
Thus all claims are believed to be allowable.

CONCLUSION

Applicant respectfully submits that the claims define a patentable invention. Accordingly, a Notice of Allowance is believed in order and is respectfully requested. If the Examiner notes any further matters which she believes may be resolved by a telephone interview, she is encouraged to contact the undersigned by telephone at 650-493-3400.

Respectfully submitted,

Date: 3/17/06

By: 
Roberta L. Robins
Registration No. 33,208
Attorney for Applicant

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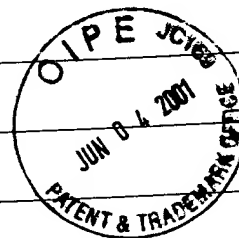
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ATTORNEY DOCKET 0800-0023 DATE June 1, 2001
1003CIP3

TRANSMITTAL LETTER
BLANKET PETITION FOR EXTENSION OF TIME...
COMBINED DECLARATION AND POWER OF ATTORNEY
SMALL ENTITY DETERMINATION
CHECK \$ 877

PAPER: _____
INVENTOR: Peter COLOSI
SERIAL NO.: 09/839,583
FILING DATE: April 20, 2001



RECEIVED BY THE UNITED STATES PATENT AND TRADEMARK OFFICE



File Dkt 0800-0023
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PATENT

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on June 1, 2001.

6/1/01
Date

Peter K. Jones
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Peter COLOSI

Serial No.: 09/839,583

Group Art Unit: Unassigned

Filing Date: April 20, 2001

Examiner: Unassigned

Title: POLYNUCLEOTIDES FOR USE IN RECOMBINANT ADENO-ASSOCIATED VIRUS VIRION PRODUCTION

TRANSMITTAL LETTER

Assistant Commissioner for Patents
Box Missing Part
Washington, D.C. 20231

COPY

Sir:

In order to fulfill the formalities requirement in the above-identified application, the following documents are submitted: Combined Declaration and Power of Attorney signed by the inventors; Small Entity Determination in the U.S. and a Blanket Petition for Extension of Time and Authorization to Charge or Credit Deposit Account. Also enclosed is a check in the amount of \$877 (surcharge, \$65; statutory basic filing fee, \$355; additional claim fees, \$320) to cover the fees required. Applicants claim small entity status.

The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

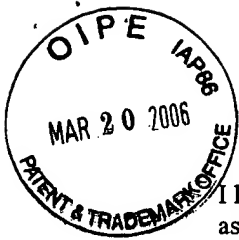
Respectfully submitted,

Date: 6/1/01

By: Roberta L. Robins

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Case Dkt 0800-0023
1003/CIP3
PATENT

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6/1/01
Date

Patricia K. Robins
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Peter COLOSI

Serial No.: 09/839,583

Group Art Unit: Unassigned

Filing Date: April 20, 2001

Examiner: Unassigned

Title: POLYNUCLEOTIDES FOR USE IN RECOMBINANT ADENO-ASSOCIATED
VIRUS VIRION PRODUCTION

**BLANKET PETITION FOR EXTENSION OF TIME AND
AUTHORIZATION TO CHARGE OR CREDIT DEPOSIT ACCOUNT**

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

If a paper is untimely filed in this application or any file wrapper continuation application derived therefrom by applicant(s) or her/his/their representative, the Commissioner is hereby petitioned under 37 C.F.R. § 1.136(a) for the minimum extension of time required to make said paper timely. In the event a petition for extension of time is made under the provisions of this paragraph, the Commissioner is hereby requested to charge any fee required under 37 C.F.R. § 1.17(a)-(d) to Deposit Account No. 18-1648. This, however, is not authorization to pay the issue fee.

If a paper is concurrently or subsequently filed in this application or any file wrapper continuation application derived therefrom by applicant(s) or her/his/their representative and a fee under 37 C.F.R. §§ 1.16-1.17 is required to effect any amendment, petition or other action requested in said paper, the Commissioner is hereby requested to charge any deficiency in said fee, or credit any overpayment of said fee, to Deposit Account No. 18-1648. This, however, is not authorization to pay the issue fee.

Respectfully submitted,

Date: 6/1/01

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Atty Dkt No. 0800-0023
1003.CIP3

COMBINED DECLARATION AND POWER OF ATTORNEY
FOR UTILITY PATENT APPLICATION

AS A BELOW-NAMED INVENTOR, I HEREBY DECLARE THAT:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if more than one name is listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: POLYNUCLEOTIDES FOR USE IN RECOMBINANT ADENO-ASSOCIATED VIRUS VIRION PRODUCTION the specification of which

___ is attached hereto
X was filed on April 20, 2001

and assigned Serial No. 09/839,583

I HAVE REVIEWED AND UNDERSTAND THE CONTENTS OF THE ABOVE-IDENTIFIED SPECIFICATION, INCLUDING THE CLAIMS, AS AMENDED BY ANY AMENDMENT REFERRED TO ABOVE.

I acknowledge and understand that I am an individual who has a duty to disclose information which is material to the patentability of the claims of this application in accordance with Title 37, Code of Federal Regulations, §§ 1.56(a) and (b) which state:

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated

through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office,

or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

I do not know and do not believe this invention was ever known or used in the United States of America before my or our invention thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to said application. This invention was not in public use or on sale in the United States of America more than one year prior to this application. This invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on any application filed by me or my legal representatives or assigns more than six months prior to this application.

I hereby claim priority benefits under Title 35, United States Code § 119(e)(1) of any United States provisional application(s) for patent as indicated below and have also identified below any application for patent on this invention having a filing date before that of the application for patent on which priority is claimed:

<u>Application No.</u>	<u>Date of Filing (day/month/year)</u>	<u>Priority Claimed</u>
60/200,453	28 April 2000	Yes <u>X</u> No <u> </u>

I hereby appoint the following attorneys and agents to prosecute that application and to transact all business in the Patent and Trademark Office connected therewith and to file, to prosecute and to transact all business in connection with all patent applications directed to the invention:

Roberta L. Robins, Reg. No. 33,208
Dahna S. Pasternak, Reg. No. 41,411
Gary R. Fabian, Ph.D., Reg. No. 33,875
M. Christina Thomson, Reg. No. 43,190
Kenneth G. Chahine, Reg. No. 42,398


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Address all telephone calls to: Roberta L. Robins at (650) 325-7812.

This appointment, including the right to delegate this appointment, shall also apply to the same extent to any proceedings established by the Patent Cooperation Treaty.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signature: 

Full Name of Inventor: Peter COLOSI

Citizenship: US

Residence: Alameda, CA

Post Office Address: 2016 Encinal Avenue, Alameda, CA 94501

Date: 



COPY

Small Entity Determination in the U.S. for the Case Entitled "POLYNUCLEOTIDES FOR USE IN RECOMBINANT ADENO-ASSOCIATED VIRUS VIRION PRODUCTION" (Serial No.09/839,583; Atty Dkt No. 0800-0023)

PLEASE READ AND MAKE THE APPROPRIATE SELECTION

Small entity according to U.S. Patent Office rules applies to patents owned by inventors, small business concerns with fewer than 500 employees, and non-profit organizations. If there is any assignment of rights or obligation to assign rights to a large entity, i.e. a firm with more than 500 employees, or if the application has been licensed to a large entity, then large entity applies.

☒ According to the above description, Avigen, Inc. is a small entity in the U.S.

☐ According to the above description, Avigen, Inc. is a large entity in the U.S.

Signature: _____

Name: _____

Title: _____

Date: _____

5/18/01